

REMARKS

**DRAFT**

These remarks are responsive to the Office Action dated July 30, 2003. Currently, claims 1-8 and 20-30 are pending in the application with claims 1, 20, 22, 23, and 30 being independent.

In the Office Action, dated July 30, 2003, the Examiner objected to the specification.

In the Office Action, dated July 30, 2003, the Examiner rejected claims 28 and 30 under 35 U.S.C. 112, ¶ 1, as containing subject matter which was not described in the specification.

The Applicants respectfully traverse the Examiner's rejection.

In the Office Action, dated July 30, 2003, the Examiner rejected claims 20-21, 23-28, and 30 are rejected under 35 U.S.C. 112, ¶ 2. The Applicants respectfully traverse the Examiner's rejection.

In the Office Action, dated July 30, 2003, the Examiner rejected claims 1, 8, 20-22, and 29-30 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,012,826 to Chabert (hereinafter "Chabert"). This rejection is respectfully traversed.

In the Office Action, dated July 30, 2003, the Examiner rejected claims 2-4, 7, 23-24, and 26 as being unpatentable in view of various combinations of Chabert with at least one of U.S. Patent No. 5,108,338 to Margolis (hereinafter "Margolis") and two Official Notices taken by the Examiner. These rejections are respectfully traversed.

35 U.S.C. 102

In the July 30, 2003 Office Action, the Examiner rejected claim 1 as being anticipated by Chabert.

On page 5, paragraph 10, of the Office Action, the Examiner stated the following:

**DRAFT**

Chabert discloses in Figs 1-6, an inflatable object [balloon 1], a shell [envelope 2], a circuit coupled to the interior portion [Fig. 5] and a switch 25, which is configured to automatically change from the open circuit position to the closed circuit position as the inflatable apparatus is inflated [col. 1 lines 19-27]

**DRAFT**

The requirement in claims 1 and 21 for a tab is met by either end part 21 or actuation contact 26 wherein the proximal portion of the tab is in contact with the switch and the distal portion of the tab is coupled to the inflatable device as recited in claim 1 and the distal portion of the tab is coupled to interior surface as recited in claim 8. (See, Office Action, Page 5, Section 10, Paragraphs 1-2).

The Applicants would like to point out to the Examiner that Chabert includes only FIGS.

1-4. Therefore, Examiner's reference to Figs. 1-6 and Fig. 5 of Chabert is improper. Furthermore, Chabert neither describes balloon 1, nor envelope 2, nor switch 25 in col. 1, lines 19-27, as suggested by the Examiner, as well as it does not describe end part 21 and actuation contact 26. Moreover, in Chabert there are no elements marked with numerals 1, 2, or 21. Numeral 25 describes a tubular pole or a post that supports the balloon 10, but is completely different from the switch of claim 1 in the present Application. Numeral 26 describes a reverse U-shaped bracket that provides mechanical rigidity to Chabert's illuminating device 14 and is not an actuation contact, as stated by the Examiner. This is also different from the tab recited in the present claim 1.

Thus, the rejection is improper under MPEP 706.02(a). The Examiner is respectfully requested to withdraw her rejection of claim 1. Similarly, rejections of claims 8, 20-22, and 29-30 is improper for at least the same reasons stated above with respect to claim 1. Thus, the Examiner is respectfully requested to withdraw her rejection of claims 8, 20-22, and 29-30.

Even though Examiner improperly used Chabert to reject claim 1 of the present application, Chabert does not anticipate claim 1 for the following reasons.

**DRAFT**

**DRAFT**

Claim 1 recites an apparatus for minimizing current flow in a circuit, where the apparatus includes an inflatable device having an interior surface, a circuit comprising a power source and a switch electrically coupled to the power source, the circuit being coupled to the interior surface. The switch has an open position, which prevents current from flowing from the power source, and a closed position, which allows the current to flow from the power source through the circuit. The apparatus includes a tab having a proximal portion and a distal portion, where the proximal portion of the tab is in contact with the switch and the distal portion of the tab is coupled to the inflatable device and where the tab is arranged to move relative to the switch and to change the position of the switch from the open position to the closed position upon inflation of the inflatable device.

Chabert on the other hand discloses an illuminating balloon having an inflatable envelope, an electric bulb, and an integrated control unit. Once the balloon is inflated, the control unit supplies power to the light bulb to light the balloon. The control unit and the light bulb are plugged into a main power supply. The balloon also includes an electropneumatic fan to inflate and deflate it. However, Chabert's balloon does not include a circuit that has a power source and a switch, where the switch is capable of being interchanged between open and closed positions. Further, Chabert does not describe a tab that is arranged to move relative to the switch and to change the switch's position from open to close, when the inflatable device is inflated, as recited in claim 1.

Thus, even if the anticipation rejection using Chabert was proper, Chabert does not describe all elements of claim 1. Claims 8, 20-22, and 29-30 are not anticipated by Chabert for

**DRAFT**

**DRAFT**

at least the same reasons stated above with respect to claim 1. Even if the rejections of claims 1, 8, 20-22, and 29-30 were proper, they are now traversed.

35 U.S.C. 103

In the July 30, 2003 Office Action, the Examiner rejected claims 2-4, 7, 23-24, and 26 under 35 U.S.C. 103(a) as being unpatentable over various combinations of Chabert with Margolis and two Official Notices.

Claims 2-4, 7, 23-24, and 26 are dependent on respective claims 1 and 22. Because rejection of claims 1 and 22 is improper and Chabert does not anticipate claims 1 and 22, Chabert also does not disclose all the elements of claims 2-4, 7, 23-24, and 26. However, neither Margolis nor the two Official Notices taken by the Examiner overcome the deficiencies of the combination of Chabert with regard. Therefore, this rejection is traversed. The Examiner is respectfully requested to reconsider and withdraw her rejection of claims 2-4, 7, 23-24, and 26 based on the combination of Chabert, Margolis and the two Official Notices.

35 U.S.C. 112

In the July 30, 2003 Office Action, the Examiner rejected claims 28 and 30 under 35 U.S.C. 112, ¶ 1 "as containing subject matter not described in the specification in such a way as to enable one skilled in the art ... to make and/or use the invention. These rejections are traversed for the reasons set forth below.

With respect to claim 28, the Examiner stated that "it is not clear how the tab is arranged to extend through the valve and enables a manual change of the switch position." (See, Office Action, page 3, section 5). The Applicant directs Examiner's attention to FIGS. 3 and 4, page 3,

**DRAFT**

**DRAFT**

lines 7-11, page 6, lines 15-21, and also to page 7, lines 11-23 of the specification, where the tab, its functions, and operation is described. The position switching element (also referred to as a "tab" or "insulating material 65") cooperates with the switch 40 of the device 100 (which can be any device according to page 5, lines 11-15 of the specification) to move the switch 40 from an open to a closed position upon inflation of the device. The Applicants respectfully request that the Examiner review the above sections and withdraw her rejection of claim 28.

With respect to claim 30, the Examiner stated that "it is not clear how the position switching elements is capable of altering between the closed position and the open position of the switch upon the change in the external device's operating states." (See, Office Action, page 3, section 5). The Applicants direct Examiner's attention to page 3, lines 7-11, page 4, lines 13-14, page 5, lines 19-20, page 6, lines 9-10 and 15-21, and also to page 7, lines 1-4 and 11-23, of the Applicants' specification, where the position switching element, its functions, and operation are fully described. The position switching element (also referred to as a "tab" or "insulating material 65") cooperates with the switch 40 of the device 100 (which can be any device according to page 5, lines 11-15 of the specification) to move the switch 40 from an open to a closed position upon inflation of the device. Therefore, the Applicants have fulfilled the written description requirement of 35 U.S.C. 112, ¶ 1, contrary to the Examiner's contention. This rejection is respectfully traversed and the Applicants request that the Examiner withdraw her rejection.

In the July 30, 2003 Office Action, the Examiner rejected claim 30 under 35 U.S.C. 112, ¶ 1 as containing new matter with respect to the "position switching element" recited above. The Applicants direct Examiner's attention to page 3, lines 7-11, page 4, lines 13-14, page 5, lines

**DRAFT**

**DRAFT**

19-20, page 6, lines 9-10 and 15-21, and also to page 7, lines 1-4 and 11-23, of the Applicants' specification, where the position switching element, its functions, and operation are fully described. As described above, the position switching element (or "tab" or "insulating material 65") moves relative to the switch's 40 open and closed position upon inflation of the device. Once the position switching element is removed from the switch 40, the switch moves into the closed circuit position. Thus, the Applicants did not introduce new matter in claim 30, contrary to the Examiner's suggestion. Further, according to MPEP 2173.01:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. MPEP 2173.01.

The term "position switching element" is adequately defined in the specification and claims. This rejection is traversed. The Examiner is respectfully requested to reconsider and withdraw her rejection of claim 30.

In the July 30, 2003 Office Action, the Examiner rejected claims 20-21, 23-28, and 30 under 35 U.S.C. 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention.

In reference to claims 20, 24, and 27, the Examiner stated that "it is not clear how the word "automatically" is intended to further limit the device." (See, Office Action, page 4,

**DRAFT**

**DRAFT**

section 8). The Applicants direct Examiner's attention to page 3, lines 15-17 of the Applicants' specification, where the switch is being configured to automatically change to a closed circuit position as the inflatable device is inflated. The "automatically" limitation is therefore fully described. Thus, this rejection is traversed. The Examiner is respectfully requested to reconsider and withdraw her rejection of claims 20, 24, and 27.

In reference to claim 23, the Examiner stated that "it is not clear how the tab is configured to change the switch from the open circuit position to the closed circuit position." (See, Office Action, page 4, paragraph 8). The Applicants direct Examiner's attention to FIGS. 3 and 4, page 3, lines 7-11, page 6, lines 15-21, and also on page 7, lines 11-23 of the specification, where the tab, its functions, and operation is described. The tab or insulating material 65 is arranged to alternate between switch's 40 open and closed positions as the inflatable device 100 is either deflated or inflated. Thus, the specification provides adequate description of how the tab is configured to change the switch from the open circuit position to the closed position. Thus, this rejection is traversed. The Examiner is respectfully requested to reconsider and withdraw her rejection of claim 23.

In reference, to claim 30, the Examiner stated that "it is not clear how position switching element is capable of altering between the closed position and the open position of the switch upon the change in the external device's operating states." (See, Office Action, page 4, paragraph 8). The Applicants direct the Examiner's attention to FIGS 3 and 4, and page 3, lines 7-11, page 4, lines 13-14, page 5, lines 19-20, page 6, lines 9-10 and 15-21, and also to page 7, lines 1-4 and 11-23, of the Applicants' specification, where the position switching element, its functions, and operation are fully described. The position switching element (also referred to as "tab" or

**DRAFT**

**DRAFT**

"insulating material 65") is capable of alternating between switch's 40 open and closed circuit positions (different states) upon deflation and inflation of the device 100. Thus, this limitation is adequately described. This rejection is traversed. The Examiner is respectfully requested to reconsider and withdraw her rejection of claim 30.

**Other Matters**

In the Office Action, dated July 30, 2003, the Examiner objected to the specification under 37 C.F.R. 1.75(d)(1) and MPEP 608.01(o) as failing to provide proper antecedent basis for the claimed subject matter. The Examiner objected to claims 20, 24, 27, 28, and 30.

The Applicants direct the Examiner's attention to the Applicants' specification sections cited above corresponding the appropriate claims and cited claim limitation. The specification sections provide sufficient antecedent basis for all objected claim terms.

The Applicants would like to note an inconsistency between form PTO-326, entitled "Office Action Summary" (hereinafter, "PTO-326"), enclosed with the July 30, 2003 Office Action, and the text of the Office Action on pages 2-9 (hereinafter, "Office Action text"). Specifically, PTO-326 (specifically, sections 4-7, entitled "Disposition of Claims") states that claims 1-8 and 20-30 are pending in the application, claim 30 is withdrawn from consideration, claims 1-8 and 29 are allowed, claims 20-24 and 26-28 are rejected, claim 25 is objected to. On the other hand, the Office Action text states that claims 1-4, 7-8, 20-24, and 26-30 are rejected and claims 5-6 and 25 are objected to. To observe formalities associated with preserving consistency of the file wrapper, the Applicants respectfully request an appropriate correction.

**DRAFT**



**DRAFT**

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Respectfully submitted,

**DRAFT**

Date: October 27, 2003

Boris A. Matvenko  
Reg. No.: 48,165  
GIBBONS, DEL DEO, DOLAN,  
GRIFFINGER & VECCHIONE, P.C  
One Pennsylvania Plaza, 37th Floor  
New York, New York 10119  
(212) 649-4700

**DRAFT**